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09/600,593	07/19/2000	Christian Lutz	1959/49027	5222

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EXAMINER

BINDA, GREGORY JOHN

ART UNIT

PAPER NUMBER

3629

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#14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/600,593

Applicant(s)
Lutz

Examiner
Greg Binda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 29 & 31 and Oct 23, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-38 is/are pending in the application.
- 4a) Of the above, claim(s) 22, 24, 26, 28, and 31-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20, 21, 23, 25, 27, 29, 30, and 36-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on May 29, 2001 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 20) ☐ Other: _____

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Election/Restriction

1. Applicant's election without traverse of Species I (Figs. 1-3) in Paper No. 11 is acknowledged.
2. Claims 22, 24, 26, 28 & 31-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11.

Specification

3. The specification is objected to as failing to comply with 37 CFR 1.71 and 1.75(d)(1) because the detailed description fails to provide proper antecedent basis for the following claimed subject matter:
 - a. Claim 20, lines 5-9.
 - b. Claim 29, lines 6 & 7.
4. The disclosure is objected to because on page 12, second full paragraph, first sentence (added in the amendment filed May 29, 2001), the numeral "32" should be changed to "37".

Claim Rejections - 35 U.S.C. § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. In order to speed prosecution, the 112 rejections below include bracketed italicized text noting rejections which would have been made with regard to the withdrawn claims had those claims been examined.

7. Claims 20, 21, 23, 25, 27, 29, 30 & 36-38 [*and 22, 24, 26, 28 & 31-35*] are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 20 recites the limitation "the ball" in lines 5 & 9. There is insufficient antecedent basis for this limitation in the claim because a ball is not previously recited.

b. Claim 20, line 6 [*; claim 33, line 2; claim 34, line 4; & claim 35, line 4*] recites "its", but it's unidentified.

c. Claim 20 recites the limitation "the other shaft end" in lines 6-8. There is insufficient antecedent basis for this limitation in the claim because no single shaft end has been previously identified.

d. Claim[s] 23 [*and 22 & 24*] recites the limitation "the resilient mounting". There is insufficient antecedent basis for this limitation in the claims because the resilient mounting is not previously recited. (Note "the resilient mounting" recited in these claims is between a socket and

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a fork (see page 9, line 17+). It is not the resilient mounting implied in claim 20, line 9 which is between a ball and a socket.)

e. Regarding claims 21, 23, 30 & 38 [*and 22, 24, 26, 31, 32, 34 & 35*] the term "preferably" renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

f. [*Regarding claim 24, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).*]

g. Claim 27, line 2; [*claim 31, line 4; claim 32, line 3; claim 34, line 5; claim 35, line 5*] recite "it", but it is unidentified.

h. Claim 36, line 3; claim 37, lines 2, 3 & 6 [*and claim 28, line 2; claim 32, lines 3 & 6*] recite the limitation "the ball". There is insufficient antecedent basis for this limitation in the claim because the limitation lacks antecedent basis in an intervening claim.

i. [*Claim 33, line 4 recites "ball". It is unclear if this "ball" is the same as, or different from "the ball" recited in an intervening claim.*]

j. [*Claim 35, line 5 recites "it can breathe." It is not clear how the claimed invention, presumably an inanimate object, can "breathe".*]

k. Regarding claim 38, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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1. It is not clear how a cross joint could be a homokinetic joint, but not a constant velocity joint as recited in claim 38 in the following limitation: "a homokinetic joint such as a constant velocity joint . . . or . . . a cross joint."

Claim Rejections - 35 U.S.C. § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 20, 21, 27, 29, 30 & 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Onuma, US 4,207,757. Fig. 1 shows a steering shaft double joint for motor vehicles (col. 1, line 10) with shaft end 33 and another shaft end nominally indicated by numeral 32 (see col. 2, line 67) each shaft end connected non-rotatably in a joint 10, 12 and being movably mounted in a housing 14 (see also col. 2, lines 48-62) connecting the two joints 10, 12; the two shaft ends 32, 33 being connected with one another between the two joints by a ball joint so that the ball 44 is rotatable around its midpoint in the socket 39 of a shaft end and is slidably movably mounted in the direction of the shaft axis of a shaft end; wherein the ball 44 is resiliently mounted (by spring 45) in the socket. Figs. 1 & 3 show the socket 39 surrounds a slide bushing 72. Figs. 2 & 3 show that the bushing 72 is held by a slotted 80 tumbler guide 70. Figs. 1 & 2 show pre-biased resilient

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structure 58 disposed between a first abutment on the side of fork 12 and a second abutment on the side of tumbler guide 70.

10. Claims 20 & 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Stokely, US 2,986,022. Figs. 1-3 shows a homokinetic (see title) steering shaft double joint for motor vehicles with shaft ends 16, 25 each connected non-rotatably in a joint 10, 11 and being movably mounted in a housing 12 connecting the two joints 10, 11; the two shaft ends 16, 25 being connected with one another between the two joints by a ball joint 13 so that the ball 37 is rotatable around its midpoint in the socket 40 of a shaft end and is slidably movably mounted in the direction of a shaft axis of a shaft end; wherein the ball 37 is resiliently mounted (by spring 43) in the socket 40. Fig. 2 shows the receptacle 40 surrounds a slide bushing 42. Fig. 1 shows a stop means (see annular protrusion just above and slightly to the left of numeral 13) on the inside wall of housing 12.

11. Claims 20, 21, 27, 36 & 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Bouchard et al, US 3,029,618. Figs. 1 & 2 show a homokinetic (see "constant velocity" in col. 1, line 14) steering shaft double joint for motor vehicles with shaft ends a, B each connected non-rotatably in a cross joint C, D and being movably mounted in a housing 3 connecting the two joints C, D; the two shaft ends a, B being connected with one another between the two joints by a ball joint so that the ball 11 is rotatable around its midpoint in the socket 10 of a shaft end and is

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slidably movably mounted in the direction of the shaft axis of a shaft end; wherein the ball 11 is resiliently mounted (by rubber element 13) in the receptacle 10. Fig. 8 shows the socket 10 surrounds a supporting sleeve/bushing 20, 21 and a tumbler guide 29 is located in between the socket 10 and the bushing 20, 21. The inside wall of housing 3 provides a stop structure for the ball 11 and receptacle 10.

12. Claims 20 & 38 are rejected under 35 U.S.C. 102(b) as being anticipated by King et al, US 3,835,667 (King). The figure shows a steering shaft double joint for motor vehicles with shaft end 12 and another shaft end 38 each connected non-rotatably in a joint 19, 39 and being movably mounted in a housing 48 connecting the two joints 19, 39; the two shaft ends 12, 38 being connected with one another between the two joints by a ball joint so that the ball 56 is rotatable around its midpoint in the socket 60 of a shaft end and is slidably movably mounted in the direction of the shaft axis of the other shaft end; wherein the ball 56 is resiliently mounted (by spring 90) in the socket. The figures show the socket 60 surrounds a slide bushing 66.

Claim Rejections - 35 U.S.C. § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 23 & 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onuma in view of Bell, US 4,160,626. Onuma shows all the limitations of the claimed invention including a metal compression spring 45 (see also col. 3, line 25), but Onuma does not expressly disclose the compression spring 45 in the form of plate springs. In Fig. 3, Bell shows plate springs 92 and teaches in col. 4, lines 40-48, using these springs in order to provide sufficient compression. It would have been obvious to one of ordinary skill in the art to modify the double joint of Onuma by making the spring 45 in the form of plate springs in order to provide sufficient compression as taught by Bell.

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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16. Claims 20, 21, 27, 38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14, 23, 29 of copending Application No. 09/600,556. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of the instant claims are included in the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 36 & 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 31 & 32 of copending Application No. 09/600,556. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only limitations not common to both sets of claims are clearly taught in both applications. The resilient mounting and slide bushing recited in instant claim 20, lines 9 & 10 (and thereby in instant claims 36 & 37) are the *only* limitations not common to both sets of claims. However the copending application clearly teaches a resilient mounting and slide bushing. See for example resilient mounting 12 and slide bushing 11 in Figs. 1 & 2 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Response to Arguments

18. Applicant's arguments filed May 29, 2001, with regard to the specification objections above have been fully considered but they are not persuasive. Applicant argues that the noted claim limitations are "clearly described in specification," but does not specify where in the detailed description such description occurs. Thus the argument is unpersuasive.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (703) 305-2869. The examiner can normally be reached Tuesday through Friday from 9:30 am to 7:00 pm. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne, can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-4195, 305-3597 and 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Greg Binda
Patent Examiner